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IN THE

Supreme Court of the United States

October Term, 1970

Nos. ——

PACKAGE DEVICES, INC., *Petitioner*

v.

SUN RAY DRUG CO., *Respondent*

PACKAGE DEVICES, INC., *Petitioner*

v.

OWENS-ILLINOIS GLASS COMPANY, *Respondent*

PACKAGE DEVICES, INC., *Petitioner*

v.

WYETH LABORATORIES DIVISION
AMERICAN HOME PRODUCTS
CORPORATION, *Respondent*

PACKAGE DEVICES, INC., *Petitioner*,

v.

E. J. KORVETTE, INC., *Respondent*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner, Package Devices, Inc. (Plaintiff and Appellant below), hereby petitions that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit in the above action dated September 29, 1970, affirming the decision of the United States District Court for the Eastern District of Pennsylvania.

OPINIONS BELOW

The opinion of the Court of Appeals for the Third Circuit is reported at 167 U.S. P.Q. 193 (1970) and appears infra p. 11. In this opinion, Jesnig Patent 2,620,938 was found invalid. The decision of the District Court for the Eastern District of Pennsylvania is reported at 301 F. Supp. 738 (E.D. Pa., 1969).

The Jesnig patent was held invalid in the earlier opinion of the District Court for the Eastern District of Pennsylvania and affirmed by the Court of Appeals for the Third Circuit.

JURISDICTION

The jurisdiction of this Court is invoked under 28 U.S.C. Sec. 1254(1). The federal jurisdiction of the District Court was based on 28 U.S.C. 1338.

The Supreme Court has exercised jurisdiction in cases such as those where a Court of Appeals has rendered a decision in conflict with decisions of other courts of appeal on the same matter. Supreme Court Rule 19(1)(b).

QUESTIONS PRESENTED

Does Section 35 U.S.C. 102(b) containing the critical bar date of one year prior to the filing date of a patent application include the obviousness test set forth in Section 35 U.S.C. 103?

Can more than a single reference be used to invalidate a patent under 35 U.S.C. 102(b)?

Can a patent be invalidated under 35 U.S.C. 102(b) if the claimed invention is not identically disclosed or described in the prior art?

STATUTORY PROVISIONS INVOLVED

The questions to be decided all involve 35 U.S.C. 102(b) and 35 U.S.C. 103:

35 U. S. C. 102(b):

Conditions for patentability; novelty and loss of right to patent

A person shall be entitled to a patent unless—

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

35 U. S. C. 103:

Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 19, 1952, c. 950, §1, 66 Stat. 798.

Supreme Court Rule 19(1)(b):

"Considerations Governing Review on Certiorari

"1. . . . The following, while neither controlling nor fully measuring the court's discretion, indicate the character of reasons which will be considered"

"(b) Where a court of appeals has rendered a decision in conflict with the decision of another court of appeals on the same matter; . . ."

STATEMENT OF CASE

The petitioner (plaintiff and appellant below) is Package Devices, Inc., a Pennsylvania corporation and assignee of the patent in suit. Appellees and defendants below include various manufacturers and sellers of devices alleged to infringe the Jesnig patent in suit.

The Jesnig patent relates to a closure for such items as aspirin. A flexible cap is dimensioned to fit over and close the top of a bottle. At its neck opening, the bottle has a pair of conical surfaces coming to an apex. When it is on the bottle, a downward pull by the cap produces a sealing effect. A radial pressure by an inner ring of the cap against the bottom conical surface of the container produces a second sealing effect. The apex at the conical surfaces assures that the final position of the cap is either on or off and not in between.

The claim in suit is exemplified by products sold under the trademarks "Bufferin," "Excedrin" and other products.

The Lower Court (per Fullem, J.) found Section 102-(b) inapplicable because none of the references relied upon by defendants met the stringent standard of identity required by this section. However, the Lower Court dismissed the complaint and held that the Jesnig patent was invalid and not infringed.

The holding of invalidity was based on obviousness under 35 U.S.C. 103 and was made as a result of considering references which came into being after the date of the Jesnig invention. The holding of non-infringement was based on limiting the doctrine of equivalence because of prior art which also included references which came into being after the Jesnig invention. Consequently, both the holdings of invalidity and non-infringement by the District Court were based on consideration of references occurring after the Jesnig invention.

On appeal, the Court of Appeals for the Third Circuit

upheld the District Court in declaring the Jesnig patent invalid. However, it stated that the District Court did not apply the correct standard of law in basing its decision of invalidity on 35 U.S.C. 103. The Court of Appeals held that patentability was barred to Jesnig under Section 102(b). This holding of the Court of Appeals followed the case in Application of Foster, 343 F. 2d. 980 (CCPA 1965) cert. denied 383 U.S. 966 (1966). The Court of Appeals agreed with the District Court on the question of infringement.

In invalidating the Jesnig patent under 35 U.S.C. 102(b), the Court of Appeals for the Third Circuit stated that there were decisions in other Circuits seemingly contrary to its decision and the Application of Foster case.

REASONS RELIED ON FOR THE ALLOWANCE OF THE WRIT.

1. The decisional law in interpreting 35 U.S.C. 102(b) and 35 U.S.C. 103 is not certain or consistent, and the decision below is in conflict with decisions of other Courts of Appeals, namely the Ninth and Tenth Circuits, and the Court of Claims.

In *Walker v. General Motors Corp.*, 362 F. 2d 56, 58 (9 Cir. 1966) the Court of Appeals for the Ninth Circuit affirmed a lower Court's ruling of a summary judgment holding a Walker patent invalid on the grounds of obviousness under 35 U.S.C. 103. The Court of Appeals decided this after holding that granting of a summary judgment by the lower Court on the grounds of anticipation under 35 U.S.C. 102(b) was inappropriate. References relied upon were over two years prior to the filing date of the Walker patent.

In *Ceramic Tilers Supply, Inc. v. Tile Council of America Inc.*, 378 F. 2d 283, 284 (9 Cir. 1967) the Court of Appeals for the Ninth Circuit cited the *Walker v. General Motors Corp.* case (supra), stating:

> ". . . 'Unless all the same elements are found in exactly the same situation and united in the same way to perform the identical function' in a single prior art reference 'there is no anticipation.'".

The above decisions are in direct conflict with the holding of the Court of Appeals of the Third Circuit in the instant case regarding the interpretation of 35 U.S.C. 102(b).

The Court of Appeals for the Tenth Circuit held in *McCullough Tool Co. v. Well Surveys Inc.*, 343 F. 2d 381, 398 (10 Cir. 1965):

> ". . . In order for a prior patent to anticipate an invention, it is necessary that all the elements of the

> invention or their equivalents be found in one single structure or description, where they do substantially the same work in substantially the same way. . . ."

This decision of the Tenth Circuit is also in conflict with the holding of the Third Circuit in the instant case under petition.

The Court of Claims held in *Soundscriber Corp. v. United States*, 360 F. 2d 954, 960 (Ct. Cl. 1966):

> ". . . To constitute an anticipation, all the elements recited in the claim or their equivalents must be found in one unit of the prior art. . . ."

This decision of the Court of Claims is also in conflict with the holding of the Third Circuit in the instant case.

The wording of Statutes 35 U.S.C. 102(b) and 103 is clear. Section 35 U.S.C. 102(b) is a forfeiture statute in which a patent right is taken away from a person as a result of a subsequent happening, such as a public sale or use. Section 35 U.S.C. 103 involves a situation where, in fact, no patent right ever existed. Due process dictates a strict statutory interpretation of the forfeiture section 102(b), without adding conditions not already set forth in its wording.

There is no reason to assume that the Congressional intent as well as the codification of the old law are not represented by the present wording of Sections 102(b) and 103. "Anticipation" of a claimed invention always required that the basic concept involving the invention be found in a single reference, even when secondary references were used to show details not related to the basic concept.

While Section 35 U.S.C. 102(b) does not refer to identical disclosure, Section 35 U.S.C. 103 does. Section 35 U.S.C. 103 limits Section 102(b) to cases where the invention is "identically disclosed" without regard to whether the disclosure involved one or more references.

There has never been a public policy under the law before or after enactment of the present Patent Law in 1952 against an inventor proving his invention over patents having filing dates more than one year, in the absence of a statutory bar. Both before and after 1952, the filing date of a patent or copending application could be overcome by an affidavit alleging invention before the filing date of the patent or copending application. This was true even when the filing date was more than a year and the disclosure of such patent or copending application would have made obvious the invention claimed in the later application. The Patent Office follows this procedure today as evidenced by its Rule 131 (page 16).

The Patent laws include provisions to encourage early disclosure by an invention without the need to add penalties to Section 102(b). The likelihood of having his invention considered abandoned under the Patent Statutes would discourage an inventor from delaying filing his application. Also, the technological advances of our present society tend to encourage an inventor to file his application early.

CONCLUSION

Petitioner believes that it is important that all the Courts of Appeals interpret the statutes 35 U.S.C. 102(b) and 35 U.S.C. 103 in the same way. This is especially true in the case of 35 U.S.C. 102(b) which is a forfeiture statute dictating that due process be strictly employed before taking away an inventor's property right to a patent.

Wherefore your petitioner prays that a Writ of Certiorari issue to the Court of Appeals for the Third Circuit to the end that this cause may be reviewed and determined by the Court, that the judgment of the Court of

Appeals for the Third Circuit holding the Jesnig patent invalid be reversed.

Respectfully submitted,

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